

REMARKS

Examiner rejects claims 1-7 and 19-24 under 35 USC 103 as being unpatentable over Spira, Galindo and Elms.

Applicant traverses these rejections for the following reasons.

(a) Although it is not clear from Examiner's office action, Applicant presumes Examiner means to hold that it would have been obvious to a skilled artisan to modify Spira's teachings with those of Galindo and Elms, thereby to attain the claimed invention.

However, express provisions of MPEP 706.02(3) notwithstanding, Examiner has failed to provide an explanation why such proposed modification would have been obvious to this skilled artisan.

That is, Examiner has failed to show why a skilled artisan would have been motivated, on basis of the applied art, to seek to attain the claimed invention.

In still other words, Examiner has failed to identify any benefit that could obviously be expected to be gained by modifying the applied references in the exact manner defined by the claimed invention.

So, exactly what benefit would motivate a skilled artisan to seek to attain the claimed invention?

And, exactly where in the applied references is such benefit suggested?

(b) Applicant agrees that the claimed invention can readily be attained by a combination of prior art.

But that is simply not the issue.

Rather, the issue is one of motivation.

In Richdel, Inc. v. Sunspool Corp. (717 F.2d 1573 -- Fed. Cir. 1983), Chief Judge Markey presented a detailed rejection of the doctrine of combination patents, stating: "It was error for the district court to derogate the likelihood of finding patentable invention in a combination of old elements. No species of invention is more suspect as a matter of law than any other. Attempted categorization for determining various "rules" detracts from what should be the sole question: whether the claimed invention would have been obvious within the meaning of paragraph 103. Most, if not all, inventions are combinations and mostly of old elements."

Applicant's claimed invention is indeed a combination of old elements; and it is this particular combination that is claimed, and it is this particular combination that Examiner must consider with respect to obviousness.

Please remember: just because a particular combination obviously can be attained from old elements does not in any way mean that this particular combination would be obvious to seek to attain.

An unending number of combinations can be attained on basis of old elements. However, no one in his right mind proceeds to make combinations of known elements simply because such combinations can be attained. Moreover, absent clear benefit, such arbitrary combinations would not constitute inventions -- even if they were to have novelty.

However, a combination of old elements would indeed qualify as a patentable invention if it were to be both beneficial and novel.

Applicant's claimed invention belongs to the latter category.

(c) Express provisions of MPEP 706.02 notwithstanding, Examiner has not set forth -- at least not in a manner capable of being understood by a person having ordinary skill in the particular art pertinent hereto -- exactly how he would propose to modify Spira with the teachings of Galindo and Elms in such exact manner as to attain the claimed invention.

Presumably, Examiner means to hold that the power tracks disclosed by Galindo could be used for distributing the high frequency voltage provided by Spira's power supply for his lighting system (even though Mr. Fiene, an expert in this particular art, testifies to the effect that such would not be obvious).

But then -- except for the purpose of attaining the claimed invention -- how and/or where does Elm's teachings come in? --- Would Examiner propose to substitute Elm's power supply for Spira's power supply? --- If so, what benefit would be attained by so doing?

(e) Exemplary claim 2 includes a feature whereby:

"the absolute instantaneous magnitude of the track voltage is substantially equal to that of the power line voltage during a significant part of each half-cycle of the power line voltage".

This feature is neither disclosed nor suggested by any of the applied references.

(f) Exemplary claim 3 includes a feature whereby:
"the first track conductr is ... alternatingly and periodically switched between the first and the second power line terminal at the frequency of the track voltage".

This feature is neither disclosed nor suggested by any of the applied references.

(g) Exemplary claim 4 includes a feature whereby:
"the first track conductr is ... periodically connected with the first power line terminal; such that, which such connection is taking place, the electrical potential of the first track conductor is substantially that same as that of the first power line terminal".

This feature is neither disclosed nor suggested by any of the applied references.

(h) Exemplary claim 5 includes:
"voltage conditioner means ... functioning ... repeatedly and periodically to connect for a brief period of time the first track conductor with the first power line terminal".

This feature is neither disclosed nor suggested by any of the applied references.

(i) Exemplary claim 7 includes:
"voltage conditioner means ... characterized by functioning ... periodically and alternatingly to cause electrical connection between the first track conductor and the first and second power line terminals".

This feature is neither disclosed nor suggested by any of the applied references.

(j) Exemplary claim 19 includes a feature operative to provide:

"an output voltage ... of frequency substantially higher than that of the power line voltage and having an RMS magnitude that varies periodically in synchronism with, as well as in proportion with, the instantaneous absolute magnitude of the power line voltage".

This feature is neither disclosed nor suggested by any of the applied references.

(k) Exemplary claim 23 includes a feature operative to provide:

"... a high-frequency voltage to be applied to the lamp terminals ... the RMS magnitude of the high-frequency voltage being modulated in direct proportion with the instantaneous absolute magnitude of the AC power line voltage".

This feature is neither disclosed nor suggested by any of the applied references.

(1) Exemplary claim 24 includes a feature operative to provide:

"... a track voltage ... of frequency substantially higher than that of the power line voltage; the instantaneous absolute magnitude of the track voltage being substantially equal to that of the power line voltage".

This feature is neither disclosed nor suggested by any of the applied references.

CONCLUDING COMMENTS

Applicant's claims 1, 20 and 22 can plausibly be attained by combining the teachings of Galindo and Elms with those of Spira.

However, the question Examiner has totally failed to address is that of motivation.

What would motivate a skilled artisan to seek to use the teachings of Galindo and Elms to modify Spira's teachings in just such a manner as to attain the invention as defined by Applicant's claims 1, 20 and 22?

By failing to address the question of motivation, Examiner materially failed to comply with MPEP 706.02. Therefore, Examiner's latest Office Action must be considered non-responsive.



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